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10/655,387

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7299

7590 08/05/2008
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EXAMINER

PYZOCHA, MICHAEL J

ART UNIT

PAPER NUMBER

2137

MAIL DATE

DELIVERY MODE

08/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/655,387

Applicant(s)

RADATTI, PETER V.

Examiner

MICHAEL PYZOCHA

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-36 are pending.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/11/2008 has been entered.

Priority

3. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 09/244154, fails to provide adequate support or enablement in the manner provided by the first paragraph

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of 35 U.S.C. 112 for one or more claims of this application. Application No. 09/244154 fails to provide support for intercepting instant messaging or peer-to-peer or short messaging code as provided in each of the independent claims. As such the claims in the present application have an earliest effective filing date of 09/03/2003.

Response to Amendment

4. Please note that claim 9 has a status identifier of "Original" when it has been amended. Appropriate change is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-17 relate to an apparatus that contains a protocol parser and a proscribed code scanner; the specification describes a protocol parser as being, among other things, a driver and a proscribed code scanner as a virus scanner, both of which are merely software. The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the mean of 35 USC §101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 6-8, 10, 11, 18-19, 21-25, 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tso et al (US 6088803) in view of Moore et al. (US 20020163934).

As per claims 1, 3, 11, 18, 34, and 36, Tso et al discloses an apparatus and method including a protocol parser; a protocol scanner; and, a proscribed code scanner comprised of a scanning means and an indicator whereby said protocol parser intercepts instant messaging or peer-to-peer code on a communications channel and transmits said code to said proscribed code scanner through said protocol scanner (see column 6 lines 10-24 where the parser performs the functions the protocol parser and the transcode service providers perform the function of the protocol scanner).

Tso et al. fails to explicitly disclose the protocol parser is capable of discriminating among different protocols implemented on top of the transport layer.

However, Moore et al. teaches a protocol parser that discriminates between different protocols implemented at the application layer (i.e. at a layer on top of the transport layer) (see paragraphs [0046] and [0055]).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use the protocol parser of Moore et al. as the parser of the Tso et al. system.

Motivation to do so would have been to convert protocol-specific data into a common language (see Moore et al. paragraph [0046]).

As per claims 2 and 19, the modified Tso et al. and Moore et al. system discloses a translation means whereby said translation means translates said code to authorized program parameters (see Tso et al. column 6 lines 10-24 and Moore et al. paragraphs [0046] and [0055]).

As per claim 4, 6, 23, the modified Tso et al. and Moore et al. system discloses the proscribed code scanner further comprises a scanning means and an indicator means and provide an indication of the presence is scanning finds proscribed code (see Tso et al. column 3 lines 39-54).

As per claims 7 and 25, the modified Tso et al. and Moore et al. system discloses the proscribed code scanner comprises a malicious code scanner (see Tso et al. column 3 lines 39-54).

As per claims 8, 10, and 24, the modified Tso et al. and Moore et al. system discloses the protocol parser further comprises a configuration means for configuring interception parameters (see Tso et al. column 6 lines 10-24 and column 5 lines 27-43).

As per claims 21-22, the modified Tso et al. and Moore et al. system discloses returning said code to a communication channel if said indicator is negative (see Tso et al. column 3 lines 55-65).

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Tso et al. and Moore et al. system as applied above, and further in view of Syed (US 20030083977).

As per claim 9, the modified Tso et al. and Moore et al. system discloses an apparatus for processing code comprising: a protocol parser capable of discriminating among different protocols implemented on top of the transport layer (see Tso et al. column 6 lines 10-24 and Moore et al. paragraphs [0046] and [0055]) and, a proscribed code scanner; whereby said protocol parser intercepts messaging code on a communications channel and transmits said code for review by said proscribed code scanner and said protocol parser being provided to parse protocols on top the transport layer (see Tso et al. column 6 lines 10-24 and Moore et al. paragraphs [0046] and [0055]).

The modified Tso et al. and Moore et al. system discloses intercepting codes that are commonly passed over the Internet (see Moore et al. paragraphs [0046] and [0055]), but fails to explicitly disclose that the messaging code is short messaging code.

However, Syed teaches sending short messages (SMS) over the internet (see paragraph [0015]).

At the time of the invention it would have been obvious to a person of ordinary skill in the art for the modified Tso et al. and Moore et al. system to intercept short messaging code.

Motivation, as recognized by one of ordinary skill in the art, to do so would have been to monitor SMS messages.

9. Claims 5, 12, 15-17, 20, 26-29, 32-33, 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Tso et al. and Moore et al. system as applied to claims 1 and 18 above, and further in view of Johnson (US 5682428).

As per claims 12, 17, 26, and 35, the modified Tso et al. and Moore et al. system fails to disclose decrypting the code.

However, Johnson discloses decrypting data (see column 27 lines 23-56).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Johnson's method of decryption in the modified Tso et al. and Moore et al. system of code scanning.

Motivation to do so would have been to be able to reference and manipulate previously encrypted data (see Johnson column 27 lines 23-56).

As per claims 5 and 20, the modified Tso et al., Moore et al. and Johnson system discloses a certification means (see Johnson column 24 line 52 through column 25 line 8).

As per claims 15-16, 27-29, and 32, the modified Tso et al., Moore et al. and Johnson system discloses encrypting the code if the indication of a prescribed code is negative (see Johnson column 27 lines 23-56).

As per claim 33, the modified Tso et al., Moore et al. and Johnson system discloses a separate system inserted in said communications channel, and with at least one of said steps of intercepting said code; decrypting said code; scanning said code for the presence of proscribed code, and providing an indicator for the presence of said

proscribed code, occurring on said separate machine (see Tso et al and Johnson as applied to previous claims).

10. Claims 13-14 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Tso et al., Moore et al. and Johnson system as applied to claims 12 and 26 above, and further in view of Elgamal et al (US 6389534).

As per claims 13-14 and 30-31 the modified Tso et al., Moore et al. and Johnson system fails to disclose the use of SSL or S/MIME encryption.

However, Elgamal et al discloses the use of these encryption techniques (see column 4 lines 15-29).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Elgamal et al's methods of encryption to perform the encryption of the modified Tso et al., Moore et al. and Johnson system.

Motivation to do so would have been to allow for the encryption suitable for each market (see Elgamal et al column 4 lines 15-29).

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

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F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8, 10-12, 15-29 and 32-36 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S.

Patent No. 7389540 in view of Moore et al.

The claims of '540 contain limitations of claims 1-8, 10-12, 15-19 and 32-36, but fail to explicitly disclose the protocol parser is capable of discriminating among different protocols implemented on top of the transport layer that intercepts instant messaging code.

However, Moore et al. teaches a protocol parser that discriminates between different protocols implemented at the application layer (i.e. at a layer on top of the transport layer) that intercepts instant messaging code (see paragraphs [0046] and [0055]).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use the protocol parser of Moore et al. as the parser of the Tso et al. system.

Motivation to do so would have been to convert protocol-specific data into a common language (see Moore et al. paragraph [0046]).

12. Claim 9 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 7389540 in view of Moore et al. as applied above and further in view of Syed.

As per claim 9, the modified claims in view of Moore et al. teach intercepting codes that are commonly passed over the Internet (see Moore et al. paragraphs [0046] and [0055]), but fails to explicitly disclose that the messaging code is short messaging code.

However, Syed teaches sending short messages (SMS) over the internet (see paragraph [0015]).

At the time of the invention it would have been obvious to a person of ordinary skill in the art for the modified claims in view of Moore et al. system to intercept short messaging code.

Motivation, as recognized by one of ordinary skill in the art, to do so would have been to monitor SMS messages.

13. Claims 13, 14, 30 and 31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 7389540 in view of Moore et al. as applied above and further in view of Elgamal.

As per claims 13-14 and 30-31 the modified claims in view of Moore et al. fail to disclose the use of SSL or S/MIME encryption.

However, Elgamal et al discloses the use of these encryption techniques (see column 4 lines 15-29).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Elgamal et al's methods of encryption to perform the encryption of the modified claims in view of Moore et al.

Motivation to do so would have been to allow for the encryption suitable for each market (see Elgamal et al column 4 lines 15-29).

14. Claims 1-8 and 10-36 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 7404212 in view of Moore et al.

The claims of '212 contain the limitations of claims 1-8 and 10-36, but fail to explicitly disclose the protocol parser is capable of discriminating among different protocols implemented on top of the transport layer that intercepts instant messaging code.

However, Moore et al. teaches a protocol parser that discriminates between different protocols implemented at the application layer (i.e. at a layer on top of the transport layer) that intercepts instant messaging code (see paragraphs [0046] and [0055]).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use the protocol parser of Moore et al. as the parser of the Tso et al. system.

Motivation to do so would have been to convert protocol-specific data into a common language (see Moore et al. paragraph [0046]).

15. Claim 9 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 7404212 in view of Moore et al. as applied above and further in view of Syed.

As per claim 9, the modified claims in view of Moore et al. teach intercepting codes that are commonly passed over the Internet (see Moore et al. paragraphs [0046] and [0055]), but fails to explicitly disclose that the messaging code is short messaging code.

However, Syed teaches sending short messages (SMS) over the internet (see paragraph [0015]).

At the time of the invention it would have been obvious to a person of ordinary skill in the art for the modified claims in view of Moore et al. system to intercept short messaging code.

16. Motivation, as recognized by one of ordinary skill in the art, to do so would have been to monitor SMS messages.

Response to Arguments

17. Applicant's arguments with respect to claims 1-36 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gupta et al. teaches a protocol parser at the application layer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL PYZOCHA whose telephone number is (571)272-3875. The examiner can normally be reached on Monday-Thursday, 7:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael Pyzocha/
Examiner, Art Unit 2137